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In re Application of :  
BONNE, Adam :  
U.S. Application No. 10/532,071 :  
PCT No.: PCT/DK03/00713 : DECISION  
Int. Filing Date: 21 October 2003 :  
Priority Date: 21 October 2002 :  
Attorney Docket No.: 55320.001021 :  
For: A SAFETY VALVE :  
:

This decision is in response to "Petition under 37 CFR 1.182 to Remove Portion of Preliminary Amendment From the National Phase Application and Accord a Separate Application Status to an Application Filed under 35 U.S.C. 111(a)" filed 22 August 2005. The \$400 petition fee has been charged to Deposit Account no. 50-0206.

BACKGROUND

On 21 October 2003, applicants filed international application PCT/DK03/00713 which claimed a priority date of 21 October 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 29 April 2004. Pursuant to 37 CFR 1.495, the thirty-month time period for submitting the requisite basic national fee in the United States of America was to expire 30 months from the priority date, 21 April 2005.

On 21 April 2005, applicants filed the present application. The application papers filed therewith included a "Transmittal letter for U.S. National Patent Application": an authorization to charge Deposit Account no. 50-0206 \$1800 (the basic national filing fee of \$300, the examination fee of \$200, and the search fee of \$500); a copy of the international application, a Preliminary Amendment under 37 CFR 1.115; and an unexecuted declaration.

On 22 August 2005, applicants filed the present "Petition under 37 CFR 1.182 to Remove Portion of Preliminary Amendment From the National Phase Application and Accord a Separate Application Status to an Application Filed under 35 U.S.C. 111(a)" which included: a copy of the international application; a copy of the Preliminary Amendment filed 21 April 2005; a Second Preliminary Amendment under 37 CFR 1.115; and a Supplemental Preliminary Amendment under 37 CFR 1.115 for a New Application under 35 U.S.C. 111(a).

## DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.494(f):

The documents and fees submitted . . . must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states that:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

As noted above, applicants' original Transmittal Letter, filed 21 April 2005, specifically identified the accompanying submission as a submission to enter the national stage under 35 U.S.C. 371. No contradictory instructions were submitted. Accordingly, application 10/532,071 was appropriately created as a national stage application under 35 U.S.C. 371.

However, despite the statement in the Preliminary Amendment filed 21 April 2005 that no new matter was included in the amendment, the present petition states that the 21 April 2005 submission may have included new matter. Specifically, the petition states that “[a] second preliminary amendment under 37 CFR 1.115 reflecting the changes is filed herewith. Applicant request these changes out of abundance of caution because an argument could be raised that the new claim . . . contained new matter.” Subject matter beyond that disclosed in the international application cannot be entered in a national stage filing under 35 U.S.C. 371. Thus, in order for the additional subject matter included with the 21 April 2005 submission to be granted a 21 April 2005 filing date, applicants must submit a grantable petition seeking to have the disclosure of 21 April 2005 treated as a continuation-in-part application under 35 U.S.C. 111(a).

The petition herein included the required petition fee. It was filed with a copy of the complete disclosure required to complete the application, that is, the specification, claims, drawings, and preliminary amendment which contain the disclosure from the international application and the added subject matter. These materials provide all the requirements for a grantable petition.

The materials submitted with the petition will be treated as a continuation-in-part application, assigned U.S. Application number 10/536,090. Application Number 10/532,071 will continue to be processed as a national stage under 35 U.S.C. 371.

Any period of adjustment to the term of a patent under 35 U.S.C. 154(b) in either application number 10/532,071 or 10/536,090 may be reduced by the period of time beginning on the filing date accorded under 35 U.S.C. 111 and ending on the mailing date of this decision.

CONCLUSION

Applicants' petition under 37 CFR 1.182 is GRANTED.

The papers attached to the petition, originally filed on 22 August 2005, will be treated as a separate U.S. application filed under 35 U.S.C. 111(a) as a continuation-in-part of international application PCT/DK03/00713. This application will be assigned application number 10/536,090 and will be assigned a filing date of 21 April 2005.

The papers relating to application number 10/536,090 are being forwarded to the Office Of Initial Patent Examination for further processing in accord with this decision. A copy of the petition and this decision will be forwarded to application no. 10/536,090.



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